

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



Re: US Patent Application 09/068,278
Filed July 9, 1998
Art Unit 3722
Examiner Erica E. Cadugan
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Applicant: Locher et al.
Attorney Docket: (R) S11-PC/PC1/US

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1-7-02
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Commissioner for Patents
Washington, DC 20231

Reply to Advisory Action

Dear Examiner Cadugan:

This is my reply to the Advisory Action mailed September 13, 2001.

This reply is submitted under a Request for Continuing Examination.

A purpose of this response is to enable the Examiner to consider Applicant's claims, in particular Applicant's claim 88.

New Issues

This amendment to claim 88 does not raise new issues that would require further consideration and/or search. As the Examiner observed, the amendment to claim 88 narrowed claim 88. The Examiner also observed that before the amendment, claim 88 covered a positioner that relatively positioned the tool support or the cable. Therefore, the previous search and consideration of claim 88 covered both the positioner for the tool support and the positioner for the cable. Narrowing claim 88 to a positioner for the tool support merely covers a portion of the claim already searched and considered.

New Figure 33

In the Advisory Action, the Examiner objects to new Figure 33, and the discussion of new Figure 33 inserted before the last paragraph on page 36 in the specification.

In the Office Action mailed June 31, 2000, the Examiner asked for a drawing to show the features of claim 43. Claim 43 recites "cable processing tools that consist of at least one of cutting tools, severing tools, crimping tools, twisting tools, punching tools, clamping tools, marking apparatuses, and grinders." Applicant responded to the Examiner's request by submitting new Figure 33 and amending the specification on page 36 to describe new Figure 33. Figure 33 and that description disclose the tools of claim 43, but in no more detail than needed to support claim 43. Namely, "cutting tools, severing tools, crimping tools, marking apparatus and grinders and a frame in which to hold these tools. Respectfully, this addition is not "new matter". Figure 33 and the description added to the specification simply describe the embodiment of claim 43, and go no further than what the person skilled in the art would expect in an embodiment of claim 43.

The Proposed Drawing Correction

The Examiner disapproved the proposed drawing correction filed August 27, 2001 because it is not in the form of a pen and ink sketch showing the changes in red ink or with the changes highlighted. The proposed drawing correction, i.e., the addition of new Figure 33, is resubmitted herewith in a Letter to the Draftsperson of the Patent Office showing the entire Figure 33 circled in red.

The Declaration

The Examiner objects to Applicant's new Declaration. Regarding the Inventors' Declaration, an appropriate Inventors' Declaration was submitted on July 5, 1998. This Declaration identifies the present application by serial number and filing date. A copy of this Declaration is resubmitted herewith.

Foreign Patents

The Examiner objects to Applicant's assertions about the various priorities claimed, set forth in the Remarks section of the proposed Amendment After Final Action submitted on August 27, 2001.

The Examiner states that Applicant has not properly requested the benefit of priority of Swiss Patent Application 3235/95 filed 11/6/95. The Examiner acknowledges that a certified copy of the Swiss Application has been submitted to the USPTO.

Applicant hereby properly requests the benefit of priority of Swiss Patent Application 3235/95 as follows: "Applicant hereby claims foreign priority benefits under Title 35, United States Code, Section 119 (a) - (d) or Section 365 (b) of any foreign applications for patent or Inventor's certificate, or Section 365 (a) of any PCT International Application which designated at least one country other than the United States, listed below and have also identified any foreign application for patent or inventor's certificate or PCT application having a filing date before that of the application on which priority is claimed. The applications on which priority is claimed is Swiss Patent Application 3235/95 filed 11/6/95 and PCT/EP96/04790 filed 11/4/96."



M. Robert Kestenbaum
Authorized Attorney

Applicant will perfect the claim of priority of PCT/EP96/04790 by submitting a
certified copy of that application. The Examiner states that the present application was
filed as a National Stage application under 35 USC 371 and was not filed under 35 USC
111 (a). The Examiner is correct.

not
the
only
requirement

Respectfully submitted,

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I hereby certify this correspondence is being deposited with the U.S Postal Service as a
first class mail in an envelope with adequate postage addresses to Commissioner for
Patents, Washington, D.C. 20231 on October 18, 2001.

M. Robert Kestenbaum